

REMARKS/ARGUMENTS

Claims 49-53 are pending and under examination in this application. In view of the amendment filed on December 20, 2005, the claims remain only rejected under 35 U.S.C. 103(a) as allegedly obvious over Naik *et al.* (1995), as evidenced by Sobocka *et al.*, in view of Alberts *et al.* (1989) "for the same reasons set forth in the previous Office Action mailed 9/27/05."

In addressing Applicants' earlier arguments that in view of *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 and *In re Deuel*, 51 F.3d 1552 (Fed. Cir. 1995), the claimed nucleic acid molecules are not obvious over the partially purified F11 protein of Naik *et al.*, the Examiner states that the holding of the cited decisions does not apply, since "applicant claims are not directed to a particular DNA sequence molecule encoding the protein, but rather any DNA sequence that encoding [sic] the polypeptide of SEQ ID NO: 1 with or without the signal sequence." From this the Examiner concludes that "the prior art reads on Applicant's claimed invention."

The rejection is respectfully traversed.

In *In re Deuel*, two of the claims at issue (Claims 5 and 7) were picture claims, reciting a specific nucleic acid sequence encoding a protein, for which a partial amino acid sequence was known prior to the Deuel priority date. The other two claims (Claims 4 and 6), however, were genus claims, claiming all nucleic acid sequences encoding the polypeptide in question. Concerning the latter claims, the court stated:

Claims 4 and 6 are of a different scope than Claims 5 and 7. As is conceded by Deuel, they generically encompass all DNA sequences encoding human and bovine HBGFs. Written in such a result-oriented form, Claims 4 and 6 are thus tantamount to the general idea of all genes encoding the protein, all solutions to the problem. Such an idea might have been obvious from the complete amino acid sequence of the protein, coupled with knowledge of the genetic code, because this information may have enabled a person of ordinary skill in the art to envision the idea of, and, perhaps with the aid of a computer, even identify all members of the claimed genus. The Bohlen reference, however, only discloses a partial amino acid sequence, and thus it appears that, based on the above analysis, the claimed genus would not have been obvious over this prior art disclosure. We will therefore also reverse the final rejection of Claims 4 and 6 because neither the Board nor the patent examiner articulated any separate reasons for holding these claims unpatentable apart from the grounds discussed above. (Emphasis added.)

The situation in the present case is analogous. The Naik *et al.* cited against the nucleic acid claims 49-53 discloses only some short partial sequences for the encoded protein. Specifically, Naik *et al.* (1995) partially purified the F11 protein and determined a 26 amino acids long sequence, designated as the "N-terminal sequence," along with some additional short internal sequences. Sobocka *et al.* (2000), which was published after the priority date of the present application, is cited as evidence that the partially purified polypeptide of Naik *et al.* is a polypeptide (F11), which is identical to PRO302 of SEQ ID NO: 1 of the present application. What the Examiner fails to point out is that Sobocka *et al.* also show that Naik *et al.* incorrectly assigned the N-terminus of their polypeptide. In fact, the 26-amino acid sequence of Naik *et al.* is an internal sequence of F11, and not the correct N-terminal sequence.

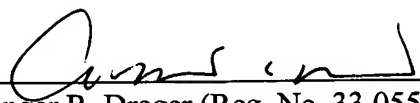
Just as in *In re Deuel*, in the present case the cited prior art reference only discloses a short partial "N-terminal" sequence and some very short internal sequences of the polypeptide, the coding sequences of which are claimed in the present application. Furthermore, even the disclosed short partial N-terminal sequence is incorrect in that the N-terminus is incorrectly assigned. Accordingly, the Examiner is respectfully requested to properly follow the U.S. Court of Appeals for the Federal Circuit's decision in *In re Deuel*, and withdraw the present rejection.

All claims pending in this application are believed to be in *prima facie* condition for allowance, and an early issuance of a Notice of Allowance is respectfully solicited.

If additional fees are determined to be due at this time, please charge such additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (Attorney Docket No. 39780-1216 R1D4).

Respectfully submitted,

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